

REMARKS

AMENDMENTS TO THE CLAIMS

Applicants have amended claims 1-2, 8-9, and 15-16 in the present application. In amending claim 1, Applicants deleted the phrase “a merchant’s” before the word “receiving” and inserted the phrase “by a merchant” after the word “receiving.” Applicants’ original claim 1 and the original specification at page 13, lines 12-17, support such amendments. Applicants further amended claim 1 by inserting the phrase “by the merchant” after the word “entering.” The original specification at page 13, lines 19-27, supports such an amendment. Applicants also amended claim 1 by adding the phrase “at a point of sale” after the word “printing.” The original specification at page 1, lines 14-17, page 8, lines 15-21, and page 14, lines 2-10, supports such an amendment. In amending claim 1, Applicants inserted the phrase “depositing, by the merchant, the check in the merchant’s depository bank” at the end of the claim. Applicants’ original claim 2 and the original specification at page 14, lines 22-27, support such an amendment.

The amendments to claims 8 and 15 are similar to the amendments to claim 1. The support for the amendments to claim 1 cited above also applies to the amendments to claims 8 and 15.

In amending claim 2, Applicants deleted the phrase “depositing the check and” after the word “comprising.” Applicants amended claim 9 by deleting the phrase “means for depositing the check and” after the word “comprising.” Applicants amended claim 16 by deleting the phrase “means, recorded on the recording medium, for depositing the check and” after the word “comprising.”

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-6, 8-13, and 15-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Andrews, *et al.* (U.S. Publication No. 2002/0103756). To anticipate claims 1-6, 8-13, and 15-20 under 35 U.S.C. § 102(e), Andrews must disclose each and every element as set forth in Appellants' claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As amended, independent claim 1 of the present application claims a method for check settlement that includes, among other limitations, printing, at a point of sale, check settlement information on a check. Andrews does not disclose printing, at a point of sale, check settlement information on a check as claimed in the present application. What Andrews in fact discloses is printing checks at a bank using information provided to the bank by an on-line customer. *See Andrews* at paragraph 0025, paragraph 0029, and reference numeral 154 of Figure 1. In fact, Andrews never even once mentions 'point of sale' or 'printing, at a point of sale, the check settlement information on the check.' Because Andrews does not disclose each and every element and limitation of Applicants' claim, Andrews does not anticipate Applicants' claims, and the rejection of claim 1 should be withdrawn.

For the reason discussed above, Andrews does not anticipate independent claim 1 in the present application. Independent claim 1, therefore, is allowable. Independent claim 8 claims system aspects of the method claimed in independent claim 1. Independent claim 15 claims computer program product aspects of the method claimed in independent claim 1. Independent claims 8 and 15 are allowable for the same reasons that independent claim 1 is allowable. The rejections of independent claims 8 and 15, therefore, should also be withdrawn, and claims 8 and 15 should be allowed.

Claims 2-6, 9-13, and 16-20 depend, respectively, from independent claims 1, 8, and 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Andrews does not disclose each and every element of the independent claims, so also Andrews cannot possibly disclose each and every element of

any dependent claim. The rejections of claims 2-6, 9-13, and 16-20, therefore, should be withdrawn, and these claims also should be allowed.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 7 and 14 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Andrews, *et al.* (U.S. Publication No. 2002/0103756) in view of Jones (U.S. Publication No. 2002/0145035). To establish a *prima facie* case of obviousness, the proposed combination of Andrews and Jones must teach or suggest all of the claim limitations of claims 7 and 14. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not demonstrate that the combination of Andrews and Jones teaches or suggests all of the claim limitations of claims 7 and 14 because the rejections of claims 7 and 14 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Andrews discloses each and every element and limitation of independent claims 1 and 8. As Applicants have demonstrated above, however, Andrews does not disclose each and every element of independent claims 1 and 8. Claim 7 depends from independent claim 1. Claim 14 depends from independent claim 8. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the proposed combination of Andrews and Jones relies on the argument that Andrews discloses each and every element of claims 1 and 8 and because Andrews in fact does not disclose each and every element of claims 1 and 8, the proposed combination of Andrews and Jones cannot teach or suggest all the claim limitations of claims 7 and 14. The proposed combination of Andrews and Jones, therefore, cannot establish a *prima facie* case of obviousness, and the rejections should be withdrawn.

CONCLUSION

Claims 1-6, 8-13, and 15-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Andrews, *et al.* (U.S. Publication No. 2002/0103756). For the reasons discussed above,

Andrews does not disclose each and every element and limitation of claims 1-6, 8-13, and 15-20. Andrews, therefore, does not anticipate claims 1-6, 8-13, and 15-20. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-6, 8-13, and 15-20.

Claims 7 and 14 are rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Andrews, *et al.* (U.S. Publication No. 2002/0103756) in view of Jones (U.S. Publication No. 2002/0145035). For the reasons discussed above, the proposed combination of Andrews and Jones does not establish a *prima facie* case of obviousness, and the rejections of claims 7 and 14 should be withdrawn. Applicants respectfully traverse each rejection individually and request reconsideration of claims 7 and 14.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: November 13, 2006

By:

Respectfully submitted,


H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS